

REMARKSStatus of the Claims

Claims 1-3 and 9-26 are pending

Claims 1-3 and 9-26 currently stand rejected.

I. Claim rejections under 35 U.S.C. 103

Claims 1-3 and 9-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hatch et al. (USPN 5,820,491) in view of official notice. The Applicants respectfully disagree with the accuracy of the statements contained within the OFFICIAL NOTICE. Accordingly, the Applicants traverse the rejection combination as improper for failing to teach each and every element of the Applicants' claims.

The examiner rejects the claims primarily upon the implied teaching of OFFICIAL NOTICE in combination with Hatch. The OFFICIAL NOTICE however is solely based upon the examiners personal knowledge. The Applicants' therefore respectfully request that the examiner provide an affidavit stating all the details of the facts surrounding the ``OFFICIAL NOTICE'' as required under CFR section 1.107. The affidavit must include specific references to publications that provide the required teaching or motivation that in combination with Hatch would produce the Applicants' invention publicly available before filing of the application.

Regarding claims 1, 3, 9, 11, 13-14, 16, 18, 24 and 26, the examiner correctly states that the Hatch `491 disclosure teaches

the use of only one metal catalyst. The OFFICIAL NOTICE states "other conventional tin catalysts such as stannous octoate are common catalysts in urethane formulation. Note, the catalyst selection(s) control the reaction rate and curing." This OFFICIAL NOTICE statement is conclusory and uses hindsight reasoning based upon the Applicants' own specification. The examiner's statements and not the prior art provides the motivation lacking in Hatch to create the Applicants' invention.

The examiner has provided insufficient evidence for making a prima facie case of obviousness when utilizing the argument that "it would have been obvious in view of Official Notice". The CCPA stated the standard under Section 103 as follows:

*[W]e have criticized the "obvious to try" test on several recent occasions. . . . [A]pplication of the "obvious to try" test would often deny patent protection to inventions growing out of well-planned research which is, of course, guided into those areas in which success is deemed most likely. These are, perhaps, the obvious areas to try. But resulting inventions are not necessarily obvious. Serendipity is not a prerequisite to patentability. Our view is that "obvious to try" is not a sufficiently discriminatory test." (See In re Lindell, 385 F.2d 453, 155 USPQ 521 (C.C.P.A. 1967)*

The art cited and motivation presented fail to produce a valid prima facie obviousness rejection of claims 1, 3, 9, 11, 13-14, 16, 18, 24 and 26. The applicants respectfully request reconsideration and allowance of claims 1, 3, 9, 11, 13-14, 16, 18, 24 and 26.

Regarding claims 2 and 12 are rejected by Official Notice because the examiner states that "it is known in the art to use

Zirconium as a catalyst for its abrasion resistance characteristic". The examiner then provides the teaching that "it would have been obvious to use Zirconium in Hatch's invention for its abrasion resistance." As the Applicants have discussed above that is an improper test for determination of obviousness.

The Federal Circuit has stated that "[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference. . . . Rather, we look to see whether combined teachings render the claimed subject matter obvious." See In re Wood, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979) (emphasis added) (citing In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (C.C.P.A. 1969)). The Hatch reference cited does not provide the required motivation to teach claims 2 and 12. The examiner has provided Official Notice in combination with Hatch citing that it was "obvious to try" as the motivation. As discussed above the "obvious to try" standard has been rejected by the courts, and therefore the examiner has failed to provide a prima facie case to reject claims 2 and 12. The Applicants respectfully request reconsideration and allowance of claims 2 and 12.

Regarding claims 10, 22 and 25, the examiner cites Hatch for teaching the use of a primer. Hatch, however, fails to teach each and every element of claims 10, 22 and 25, specifically the use of a combination of catalysts either singly or in combination with any other reference. The failure to teach each and every

element of claims 10, 22 and 25 does not provide a valid prima facie case of obviousness. Applicants respectfully request reconsideration and allowance of claims 10, 22 and 25.

Regarding claim 11, the examiner cites Hatch for teaching the use of an ionomer cover. Hatch fails to teach each and every element of claim 11, specifically the use of a combination of catalysts either singly or in combination with any other reference. The failure to teach each and every element of claim 11 does not provide a valid prima facie case of obviousness. Applicants respectfully request reconsideration and allowance of claim 11.

Regarding claims 15 and 17, the examiner cites Hatch in combination with Official Notice that *"it is conventional to use the base and/or activator as a thinner to control the viscosity and aid in curing and/or drying"*. The Applicants state again that the Official Notice is incorrect and that specific references and/or an affidavit under C.F.R. 1.107 must be presented to the Applicants to allow them to properly refute the examiner's rejections. The examiner again provides *"obvious to try"* as the motivation to reject claims 15 and 17. The Applicants respectfully disagree that a prima facie case of obviousness has been produced. The Applicants respectfully request consideration and allowance of claims 15 and 17.

Regarding claim 19, the examiner cites that Official Notice is taken that *"it is known that the pot life or coatable time is the life of the batch mixture where it allows good coating*

workability. Note, the pot life is depended on the coating process." The Official Notice presented by the examiner is only a definition of the term pot life and fails to even mention claim 19's pot life limitation. The examiner has failed to produce a prima facie case of obviousness by teaching each and every element of claim 19 even with the use of Official Notice. The Applicants respectfully request reconsideration and allowance of claim 19.

Regarding claims 20-21, the examiner cites Hatch as disclosing the functional equivalent of the claimed flourosurfactant. As discussed above, the examiner fails to provide motivation to provide at least two metal catalysts. The rejection fails to teach each and every element of the claims and thus is improper. The Applicants respectfully request reconsideration and allowance of claims 20-21.

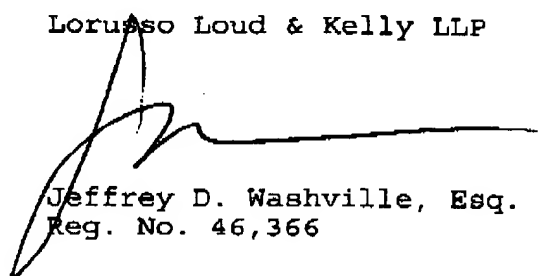
Regarding claim 23, the examiner cites Hatch for disclosing acrylic resin. As discussed above the examiner fails to provide motivation to provide at least two metal catalysts. The rejection fails to teach each and every element of the claim and thus is improper. The Applicants respectfully request reconsideration and allowance of claim 23.

The examiner has failed to provide motivation to produce each and every element of the claims. The Applicants respectfully request reconsideration and removal of the obviousness rejections of claims 1-3 and 9-26.

II. Conclusion

The Applicants respectfully request allowance of claims 1-3 and 9-26. If the examiner wishes to continue the rejection based upon Official Notice, the Applicants respectfully request specific details and citations presented in an affidavit as required under 37 C.F.R. 1.107 to allow the proper refutation of the rejections. Please feel free to contact this office collect with any questions.

Respectfully submitted,  
Lorusso Loud & Kelly LLP



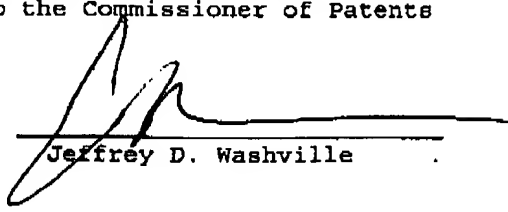
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Date: June 26, 2003

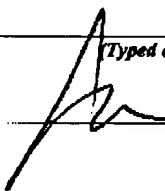
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CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this Transmittal Letter and any documents referred to as attached hereto are being FAXED to the Commissioner of Patents at (703)746-8355 on June 26, 2003.



Jeffrey D. Washville

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|---|-----------------------------------|-----------------------------------|-----------------------------------|--|
| <b>CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)</b><br>Applicant(s): <b>FENG CAO et al</b>   |                                   |                                   | Docket No.<br><b>DSCK-1215-C1</b> |  |
| Serial No.<br><b>09/745,177</b>   | Filing Date<br><b>20 DEC 2000</b> | Examiner<br><b>DUONG, THANH P</b> | Group Art Unit<br><b>3711</b>     |  |
| Invention: <b>METHOD FOR COATING A GOLF BALL WITH A DRY-ON-LINE CLEAR POLYURETHANE COMPOSITION, AND GOLF BALLS</b>  |                                   |                                   |                                   |  |
| <p>I hereby certify that this <u><b>RESPONSE TO OFFICE ACTION MAILED 26 MAR 2003</b></u><br/><i>(Identify type of correspondence)</i></p> <p>is being facsimile transmitted to the United States Patent and Trademark Office (Fax. No. <u><b>(703) 746-8355</b></u></p> <p>on <u><b>26 JUN 2003</b></u><br/><i>(Date)</i></p> <p style="text-align: right;"><u><b>JEFFREY D. WASHVILLE</b></u><br/><i>(Typed or Printed Name of Person Signing Certificate)</i></p> <p style="text-align: right;"><br/><i>(Signature)</i></p> <p style="text-align: center;">Note: Each paper must have its own certificate of mailing.</p> |                                   |                                   |                                   |  |

P18/REV01